

U.S. Patent Application Serial No. **10/721,069**
Amendment filed November 21, 2006
Reply to OA dated August 28, 2006

REMARKS

Claims 1-3, 5 and 6 are pending in this application. In the present amendment, claim 1 has been amended. Upon entry of this amendment, claims 1-3, 5 and 6 will be pending. A minor amendment is also made to the specification.

The applicant respectfully submits that no new matter has been added. It is believed that this Amendment is fully responsive to the Office Action dated **August 28, 2006**.

The disclosure is objected to because of informalities. (Office action paragraph no. 5)

The Examiner states that the trademarks in the specification are not capitalized, noting "Henschel mixer" on page 25, line 7, which is in paragraph [0064]. The objection is overcome by the amendment to the specification, capitalizing this item.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0033982 (Ishikawa) combined with US 6,897,001 B2 (Mizoe). (Office action paragraph no. 8)

The rejection is overcome by the amendment to claim 1. Claim 1 is amended:

1) to limit the colored polymer particle to be produced by a polymerization reaction and to have a core-shell structure. Support for this recitation may be found, for example, in paragraphs [0020] to [0022] of the specification.

2) To limit the external additive to "[comprise] (A) calcium phosphate particles or calcium carbonate particles having a volume average primary particle diameter in the range of 0.1 to 3.0 μm , (B) small-sized fine silica particles having a volume average primary particle diameter in the range of 5 to 18 nm; and (C) large-sized fine silica particles having a volume average primary particle diameter in the range of 20 to 60 nm." Support for this recitation may be found, for example, in paragraphs [0029] to [0032] of the specification.

Applicant submits that neither Ishikawa nor Mizoe discloses the colored polymer particle being prepared by a polymerization method and having a core-shell structure. In particular, Ishikawa is cited for disclosing a polymeric core particle comprising a binder resin, a colorant and a wax. The Examiner notes on page 6 of the Office action that Ishikawa does not explicitly state that the toner has a core-shell structure, but states on page 7 that "it is reasonable to presume that the toner in Example 6 has a core-shell structure" However, Applicant submits that the primary polymer particle of Ishikawa is not **produced by a polymerization reaction** to have a core-shell structure.

Moreover, none of the cited references discloses an external additive having components (A), (B) and (C) as recited in amended claim 1. The Examiner cites Ishikawa as disclosing externally added hydrophobic silica particles, and cites Mizoe as disclosing externally added silica particles and tungsten-containing tin oxide particles (page 8 of the Office action). However, combination of the references would not lead to the combination of components (A), (B) and (C) of amended claim 1, and there is no suggestion in the references for this limitation.

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Therefore, claims 1-3 are not obvious over US 2001/0033982 (Ishikawa) and US 6,897,001 B2 (Mizoe), taken separately or in combination.

Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/58790 (Masuo), as evidenced by applicant' admissions at page 7, line 27, page 9, lines 23-26, and page 10, lines 7-8, of the instant specification (applicant's admissions I), combined with Mizoe. (Office action paragraph no. 9)

The rejection is overcome by the amendment to claim 1. Applicant submits that neither Masuo nor Mizoe discloses the limitations added to claim 1. The teachings of Mizoe in this regard are discussed above.

Applicant notes that Masuo is cited for disclosing a toner that comprises (1) colored polymeric particles comprising a binder resin, a colorant, and other components, and (2) externally added hydrophobic particles. However, there is no disclosure or suggestion that the polymeric particles be produced by a polymerization reaction and have a core-shell structure, and there is no disclosure or suggestion in Masuo that the externally added particles have components (A), (B) and (C), recited in amended claim 1.

Claims 1-3 and 6 are therefore not obvious over WO 00/58790 (Masuo), "applicant's admissions I," and Mizoe, taken separately or in combination.

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Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuo, as evidenced by applicant's admission at page 7, line 27, of the instant application (applicant's admission II), combined with Mizoe and US 6,096,468 (Ohno). (Office action paragraph no. 10)

The rejection is overcome by the amendment to claim 1.

Applicant submits, as discussed above, that neither Masuo nor Mizoe discloses the limitations added to claim 1.

Ohno is cited (page 21 of the Office action) for the disclosure of toner particles having a circularity of from 0.950 to 0.995. However, Ohno does not disclose or suggest polymer particles produced by polymerization and having a core-shell structure, and does not disclose or suggest an external additive having components (A), (B) and (C), as recited in amended claim 1.

Claims 1-3 and 6 are therefore not obvious over Masuo, "applicant's admission II," Mizoe and US 6,096,468 (Ohno), taken separately or in combination.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masuo, as evidenced by applicant's admission I, combined with Mizoe, as applied to claim 1 above, further combined with Kitani. (Office action paragraph no. 11)

The rejection of claim 5 is overcome by the amendment of claim 1, from which claim 5 depends. As discussed above for the rejections of claim 1, neither Masuo nor Mizoe discloses the limitations added to claim 1.

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Kitani is cited (page 24 of the Office action) for disclosing toner particles having a volume average particle size of 5 to 9 μm and having a particle size distribution of 2.0 volume percent or less of particles having a particle size of 16 μm or more and 16.0 particle number or less of particles having a particle size of 5.0 μm or less.

However, Kitani does not disclose or suggest polymer particles produced by polymerization and having a core-shell structure, and does not disclose or suggest an external additive having components (A), (B) and (C), as recited in amended claim 1. Therefore, none of the cited references discloses or suggests the limitations of amended claim 1.

Claim 5 is therefore not obvious over Masuo, "applicant's admission I," Mizoe, and Kitani, taken separately or in combination.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masuo, as evidenced by applicant's admission II, combined with Ohno and Mizoe, as applied to claim 1 above, further combined with Kitani. (Office action paragraph no. 12)

The rejection of claim 5 is overcome by the amendment of claim 1, from which claim 5 depends. As discussed above for the rejections of claim 1, none of the references of Masuo, Ohno and Mizoe discloses or suggests the limitations added to claim 1. Moreover, as discussed above in regard to the rejection in paragraph no. 11 of the Office action, Kitani also does not disclose or suggest these limitations.

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Claim 5 is therefore not obvious over Masuo, "applicant's admission II," Ohno, Mizoe, and Kitani, taken separately or in combination.

In view of the aforementioned amendments and accompanying remarks, the claims, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, KRATZ, QUINTOS,
HANSON & BROOKS, LLP


Daniel A. Geselowitz, Ph.D.
Agent for Applicant
Reg. No. 42,573

DAG/bh
Atty. Docket No. 031284
Suite 1000
1725 K Street, N.W.
Washington, D.C. 20006
(202) 659-2930



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